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Attorney Docket No.: 017534-000730US

#5/85
PATENT 8.135

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450 On August 1, 2003

TOWNSEND and TOWNSEND and CREW LLP

By: JoAnn Evangelista
JoAnn Evangelista

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

RODNEY A. PERKINS et al.

Application No.: 10/017,068

Filed: December 13, 2001

For: METHODS, SYSTEMS, AND KITS
FOR LUNG VOLUME REDUCTION

Customer No.: 20350

Confirmation No.: 7372

Examiner: THOMPSON, Kathryn L.

Technology Center/Art Unit: 3763

RESPONSE

Mail Stop: 3763
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Sir:

In response to the Office Action mailed February 19, 2003, Applicants respectfully request reexamination and reconsideration of the claims in view of the following remarks.

Claims 1-5 are pending. Claims 1, 3, and 4 were rejected as being anticipated by U.S. Patent No. 6,493,589 to Medhkour et al. Claims 2 and 5 were rejected as being obvious over Medhkour in view of Dayal '175. Such rejections are respectfully traversed.

Applicants note that the present application has an effective filing date at least as early as June 28, 2000, since it is continuation of Application No. 09/606,320 filed on that date. With the possible exception of corrections of minor typographical, the Specifications of the

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present application and of the parent file on June 28, 2000, are identical. Applicants further believe that all pending claims are entitled to priority from the grandparent Application No. 09/347,032, filed on July 2, 1999. For the present, however, Applicants have no need to rely on that date.

U.S. Patent No. 6,493,589 to Medhkour has an actual filing date of August 10, 2000, which is after the effective filing date of the present application. Thus, Applicants believe that the rejections under 35 U.S.C. §102 and 102(e)/103 are improper and request that they be withdrawn.

Applicants realize that the Medhkour '589 patent claims priority from an earlier Continuation-In-Part Application No. 090/304,681, filed on May 4, 1999, now U.S. Patent No. 6,327,505, as well as an even earlier Provisional Patent Application No. 60/084,580, filed on May 7, 1998.

Applicants note, however, that Figs. 15-20 of the cited '589 patent of the cited '589 patent directed particularly at lung treatment were not included in the Parent Application No. 09/304,681 and were added in the application filed on August 10, 2000. Thus, Applicants believe that those portions of the '589 patent which are particularly directed at lung treatments are not available as prior art against the present application.

If the Examiner believes that such teachings are available, it is respectfully requested that the Examiner cite U.S. Patent No. 6,327,505, and provide reasons why the '505 patent would render the present application anticipated and/or obvious.

As an additional matter, Applicants note that certain prior art references are being made of record herein and accompany an IDS. These references were cited in an Office Action in copending related Application Number 09/898,703, which is a divisional of the Parent Application of the present application.

As a final matter, Applicants wish to remind the Examiner, as previously pointed out in the Preliminary Remarks filed together with the application, that claims 1 and 2 herein have been copied from claims 9 and 10 of U.S. Patent No. 6,258,100, which issued on July 10, 2001, from an application filed on October 10, 2000, and which claimed to be a divisional of Application of 09/379,972, filed on August 24, 1999.

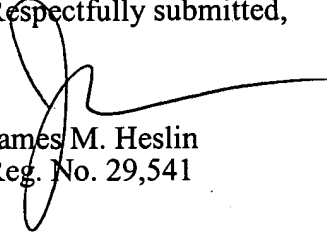
possible
interference

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If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned at 650-326-2400. In response to the Office Action mailed, please enter the following amendments and remarks:

Respectfully submitted,



James M. Heslin
Reg. No. 29,541

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Attachments
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